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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,081	11/08/2004	Martin Kreyenschmidt	260985US0PCT	2789
22850 7590 01/31/2008 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER COONEY, JOHN M	
			ART UNIT 1796	PAPER NUMBER
			NOTIFICATION DATE 01/31/2008	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/512,081

Applicant(s)

KREYENSCHMIDT ET AL.

Examiner

John Cooney

Art Unit

1796

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 8-18 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Applicant's arguments filed 11-8-07 have been fully considered but they are not persuasive.

Election/Restrictions

Claims 12 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species of invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11-8-07.

Election requirement is for examination purposes and serious burden for examination is maintained.

To the extent that already cited Hall et al. applies to claims already presented for examination, it will be retained as set forth herein.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 is confusing as to intent, because, like "obtainable", the language "obtainable by", and similar language, (rather than "obtained by") as well as such allied terms as "derivable from", "preparable from", etc. fails to particularly point out and

distinctly claim the invention since one can not determine from the phrase just which compositions are "obtainable by" applicants' processes and which are not.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8-11, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Dany et al.(3,847,843).

Dany et al. discloses preparations of polyurethane foam compositions as defined by applicants prepared from isocyanates and polyols containing materials that further include compounds reading on the inhibitors elected by applicants as claimed that as the polyurethane polymer progresses these materials become embedded in substances, the forming polyurethane polymer, meeting the substances as defined by applicants' claims to degrees as required by applicants' claims (see column 5 and example 2, as well as, the entire document).

Claims 1, 8-11, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by WO-00/66643.

WO-00/66643 discloses preparations of polyurethane foam compositions as defined by applicants prepared from isocyanates and polyols containing materials that

further include compounds reading on the inhibitors elected by applicants as claimed that as the polyurethane polymer progresses these materials become embedded in substances, the forming polyurethane polymer, meeting the substances as defined by applicants' claims to degrees as required by applicants' claims (see abstract and applicants' admissions at page 2 of their supporting disclosure, as well as, the entire document).

Claims 1-6, 8-10, and 13-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al.(4,670,483).

Hall et al. discloses preparations reading on those defined by applicants which include polyurethane compositions as defined by applicants prepared from isocyanates and polyols containing materials that further include compounds reading on inhibitors, ammonium polyphosphate (an ester), as claimed that are embedded in substances as defined by applicants' claims, as well as, being further embedded in waxes, such as montan wax ester, to degrees as required by applicants' claims (see column 8 line 6-54, as well as, the entire document). The properties of the embedding substance though not specifically highlighted by Hall et al. are inherent features associated with embedding substances disclosed by Hall et al. because such are intrinsic properties associated with the embedding substances disclosed to be employed by Hall et al.

Applicants' arguments as to the applicability of Hall et al. have been considered. However, rejection is maintained for the claims indicated in the rejection above. It is

maintained that the embedded materials of Hall et al. are inhibitors to the degree required by applicants' claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-6, 13, 14, 17, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dany et al. and WO 00/66643, taken individually, as applied to claims 1, 8-11, 15, and 16 above, and further in view of DE 100 50 417.

Dany et al. and/or WO 00/66643 differ from applicants' claims in that they do not encapsulate their active agents. However, DE-'417 discloses that it is known to encapsulate active agent in polyurethane synthesis operations for the purpose of inhibiting the active agent's effects (see translated abstract, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have encapsulated the active agents of Dany et al. and/or WO-'643 in the manner provided for by DE-'417 for the purpose of inhibiting their active effects in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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